

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUN 21 2006 Ex parte M. ALLEN NORTHRUP, KURT E. PETERSEN,
WILLIAM A. McMILLAN, and GREGORY T.A. KOVACS

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/271,411

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on June 6, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On June 9, 2004, the examiner entered a Final rejection. On page 3 of the Final rejection, the examiner rejected claims 45-50, 52-55, 57, 58, 60, and 62-70 under 35 U.S.C. § 103(a) as being unpatentable over Handique et al. (Handique) taken in view of Wilding et al. (Wilding) or, alternatively, Wilding taken in view of Handique. However, on page 5 of the Examiner's Answer mailed on November 22, 2005, the examiner rejects the same group of claims under 35 U.S.C. § 103(a) as being unpatentable over Handique and Wilding. Therefore, it is not clear whether the examiner erred in the restatement of this rejection, or whether the examiner has entered a new ground of rejection. According to MPEP § 1207.03 (8th ed., Rev. 1, August 2005):

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen

prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer. Clarification on the record is required.

Accordingly, it is

ORDERED that the application is returned to the examiner for:

(1) clarification of the rejection of claims on appeal;
(2) written notification to appellants of the proper rejection of claims on appeal, or if entering a new ground of rejection, to reopen prosecution to address the new ground of rejection, including obtaining approval from a TC Director or appropriate designee; and
(3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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